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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,082	12/12/2005	Shuji Hinuma	68137(46342)	9415
21874	7590	10/27/2009	EXAMINER	
EDWARDS ANGELI, PALMER & DODGE LLP			SWARTZ, RODNEY P	
P.O. BOX 55874			ART UNIT	PAPER NUMBER
BOSTON, MA 02205			1645	
MAIL DATE		DELIVERY MODE		
10/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/534,082	HINUMA ET AL.	
	<b>Examiner</b> Rodney P. Swartz, Ph.D.	Art Unit 1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 17June2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-28,60 and 62-73 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1-9,15,16,24-28,60,62-64,66 and 69-73 is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) 10-14,17-23,65,67 and 68 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_

#### **DETAILED ACTION**

1. Applicants' Response to Office Action, received 17 July 2009, is acknowledged. Claims 14, 19, 24 and 72 have been amended.
2. Claims 1-28, 60 and 62-73 are pending and under consideration.

#### **Rejections Withdrawn**

3. The rejection of claim 14 under 35 U.S.C. 112, second paragraph, as being indefinite for a period within the claim, is withdrawn in light of the amendment of the claim.
4. The rejection of claim 19 under 35 U.S.C. 112, second paragraph, as being indefinite for a period within the claim, is withdrawn in light of the amendment of the claim.
5. The rejection of claim 24 under 35 U.S.C. 112, second paragraph, as being indefinite for a period within the claim, is withdrawn in light of the amendment of the claim.
6. The rejection of claim 72 under 35 U.S.C. 112, second paragraph, as being indefinite for "pf", is withdrawn in light of the amendment of the claim.
7. The rejection of claim 26 under 35 U.S.C. 112, second paragraph, as being indefinite for dependency from a rejected claim, is withdrawn in light of the amendment of the claim.

#### **Double Patenting**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 10 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 10 is the peptide, its amide or ester, or salts thereof of claim 1.

9. Claim 11 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 6.

When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 11 is the peptide, its amide or ester, or salts thereof of claim 6.

10. Claim 12 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 10, 11 and 65. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 12 is the peptide, its amide or ester, or salts thereof of claim 10, 11, or 65.

11. Claim 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 10, 11 and 65. When two claims in an application are duplicates or else are so close in content that

they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 13 is the peptide, its amide or ester, or salts thereof of claim 10, 11, or 65.

12. Claim 14 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 10, 11 and 65. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 14 is the peptide, its amide or ester, or salts thereof of claim 10, 11, or 65.

13. Claim 17 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 15. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the diagnostic agent of claim 17 is the antibody of claim 15.

14. Claim 18 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the diagnostic agent of claim 18 is the antibody of claim 16.

15. Claim 19 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 16, 18 or 67. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the diagnostic agent of claim 19 is the antibody of claim 16, 18 or 67.

16. Claim 20 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 15. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 20 is the antibody of claim 15.

17. Claim 21 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 21 is the antibody of claim 16.

18. Claim 22 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20, 21 or 68. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 22 is the antibody of claim 20, 21 or 68.

19. Claim 23 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 20, 21 or 68. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 23 is the antibody of claim 20, 21 or 68.

20. Claim 65 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 62. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 65 is the antibody of claim 62.

21. Claim 67 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 66. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the diagnostic agent of claim 67 is the antibody of claim 66.

22. Claim 68 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 66. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The only component of the medicament of claim 68 is the antibody of claim 66.

### **Conclusion**

23. Claims 10-14, 17-23, 65, 67 and 68 are objected to. Claims 1-9, 15, 16, 24-28, 60, 62-64, 66 and 69-73 are allowed.

24. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Wednesday from 9:00 AM to 7:30 PM EST. Thursday is the examiner's work at home day.

If attempts to reach the Examiner by telephone are unsuccessful, please contact the Examiner's Supervisor, Robert B. Mondesi (571)272-0956.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Rodney P. Swartz, Ph.D./

Primary Examiner, Art Unit 1645

October 27, 2009